

REMARKS

I. Introduction

The Examiner has rejected claims 1-76 under § 103 as being rendered obvious by two separate combinations: (i) Schein et al. U.S. Patent No. 6,002,394 ("Schein") in view of Payne et al. U.S. Patent No. 6,021,433 ("Payne"), the "Schein-Payne Combination"; and (ii) Mighdoll et al. U.S. Patent No. 6,073,168 ("Mighdoll") in view of Gardell et al. U.S. Patent No. 6,049,831 ("Gardell"), the "Mighdoll-Gardell Combination". Both of these rejections are respectfully traversed.

II. Applicants' Systems and Methods of Claims 1-76

Generally speaking, claims 1-76 are directed towards various embodiments of applicants' systems and methods for providing e-mail reminders for an "Internet television program guide." As set forth in independent claims 1 and 20, for example, "television program listings" are provided "over the Internet" to a user's "multimedia system." The user selects "a television program from the television program listings," and an "e-mail reminder message" for the selected program is provided to the user's multimedia system. The e-mail reminder message "reminds the user when [the selected] television program is to be broadcast." Further patentable features and embodiments are set forth in dependent claims 2-19 and 21-76.

III. The Obviousness Rejection Based on the Schein-Payne Combination Should Be Withdrawn Because It Fails To Teach All Features Of Applicants' Claims

Applicants respectfully submit that claims 1-76 are not rendered obvious by the Schein-Payne combination. Schein broadly describes an Internet television program guide that allows users to set reminders for selected programs. Applicants' systems and methods of claims 1-76 have patentably improved upon the Schein Internet television program guide by using e-mail messages for reminders (e.g., "e-mail reminder messages").* Combining Payne with Schein would not teach that improvement. Payne does not disclose sending "e-mail reminder messages" as required by claims 1-76. Payne's system merely alerts users to the presence of e-mail.

Payne's system sends wireless alerts to users to alert them to new information from various "information sources," one of which is e-mail. Payne, col. 7, lines 43-56. After receiving the wireless alert, the user retrieves the e-mail message in order to view it in its entirety.** Payne never discloses any purpose for the e-mail messages that would suggest using them as "reminder messages." And, more importantly, there is no reason in Payne's system to do so as the Examiner seems to suggest in paragraph 7 of the

* Dependent claims 2-19 and 21-76 add further patentable features which are unnecessary to discuss because the Schein-Payne combination fails to teach this feature, which is common to all claims.

** Payne discloses that these alerts may include "notification centric portions" of the e-mail for which the alert is provided. Payne, col. 2, lines 46-64.

Office Action. Using Payne's system to provide an alert for an e-mail message that is actually a reminder for some other event would be an inefficient modification to (and undisclosed use of) the Payne system -- Payne's system already provides wireless alerts for events themselves (e.g., news and sports).

IV. The Obviousness Rejection Based on the Mighdoll-Gardell Combination Should Be Withdrawn Because It Fails To Teach All Features Of Applicants' Claims

Applicants respectfully submit that claims 1-76 are not rendered obvious by the Mighdoll-Gardell combination. Mighdoll does not disclose anywhere, including those portions cited by the examiner, any features of an Internet television program guide. Accordingly, the Mighdoll-Gardell combination fails to render obvious applicants' systems and methods of claims 1-76.

Because the combined references do not teach or suggest each claim limitation of the present invention, applicants respectfully submit that the Examiner has not overcome the burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. Accordingly, applicants request that the Examiner's rejection of claims 1-76 based on the Schein-Payne and Mighdoll-Gardell combinations be withdrawn.

V. Both Obviousness Rejections Fail Because the Examiner Does Not Provide Sufficient Evidence of a Motivation to Make the Combinations

Even if all of the features of claims 1-76 were taught by either or both of the Schein-Payne and Mighdoll-Gardell combinations as the Examiner contends, both obviousness rejections fail for another, independent reason - the Examiner has failed to provide a sufficient motivation for making the Schein-Payne and Mighdoll-Gardell combinations. See MPEP §§ 2142 and 2143.01; see also In re Rouffet, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references").

It is well-settled that an examiner can "satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the reference." In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner has showed no such objective evidence but has instead relied on the conclusory statements of paragraphs 8, 13, and 15 to support his argument that the references may be combined. However, such "broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence [of a motivation to combine]." In

re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Without objective evidence of a motivation to combine, the obviousness rejection is the "essence of hindsight" reconstruction, the very "syndrome" that the requirement for such evidence is designed to combat, and insufficient as a matter of law. *Id.* at 1617-1618. For this reason alone the rejection of claims 1-76 must be withdrawn. Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997).

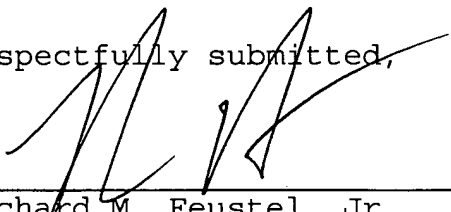
VI. Additional Remarks

In paragraph 15 of the Office Action, the Examiner states without making an additional rejection that "it also of unclear to the metes and bounds of the claim subject matter as it is presently claimed." Claims 1-76 comply with 35 U.S.C. § 112. Applicants respectfully request that, if a rejection is intended, a non-final Office action be issued setting forth the particular grounds of that rejection.

VII. Conclusion

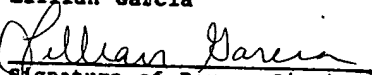
The foregoing demonstrates that claims 1-76 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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